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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,153	02/28/2002	Christiane Foertsch	32860-000278/US	4915

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EXAMINER
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JONES, HUGH M

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/084,153

**Applicant(s)**

FOERTSCH ET AL.

**Examiner**

Hugh Jones

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on 28 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/9/02; 12/20/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-26 of U. S. Application 10/084,153, filed 02/28/2002 are presented for examination.

#### **Drawings**

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Paragraph 14 of the specification indicates that figure 1 "shows an example of a technical system".

#### **Claim Objections**

3. Claims 4, 11, 14, 16-20, 21-24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As per claims 4, 11, 14, 16-20, the configuration tool is not limited by the intended use or file format. As per claims 21-24, mere embodiment on a computer medium does not further limit the claims; furthermore the claims are improperly mixing statutory classes.

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4. Claims 21-24 are recited as dependent claims; however, it appears that they should be presented as independent claims, since the claims are improperly mixing statutory classes.

**Claim Interpretation**

5. It is interpreted that limitations such as those recited in claims 17-20 recite examples of intended use and therefore are not accorded patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

**Claim Rejections - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 21-24 are rejected under 35 U.S.C. 101 because **the claims recite a computer program product**. It should be noted that code (i.e., a computer software program) does not do anything per se. Instead, it is the code stored on a computer that, *when executed*, instructs the computer to perform various functions. The following claim is a generic example of a proper computer program product claim;

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A computer program product embodied on a computer-readable medium and comprising code that, when executed, causes a computer to perform the following:

Function A

Function B

Function C, etc...

**Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gilpin et al..

MA 10. Gilpin et al. disclose :

1) A computer-aided configuration tool, into which a number of technical elements and their technical relationships can be entered, such that the elements and their relationships specify a technical system (abstract), comprising:

technical characteristics which can be set for each element in the configuration tool, wherein only the setting of technical characteristics for a first element is permissible, on the basis of which it remains compatible with a second element with

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which it is intended to be related (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 21; col. 8, lines 1-10).

2) A computer-aided configuration tool, into which a number of technical elements and their technical relationships can be entered, such that the elements and their relationships specify a technical system (abstract), comprising:

technical characteristics which can be set for each element in the configuration tool, wherein the characteristics of a first and of a second element and a relationship which exists between these elements, are used to check whether the first element is compatible with the second element (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 21; col. 8, lines 1-10).

3) The configuration tool as claimed in claim 2, wherein the elements, their technical characteristics and their relationships are read from at least one of a file and a file system (fig. 1).

4) The configuration tool of claim 3, wherein the file is an ASCII file (fig. 1).

5) The configuration tool as claimed in claim 1, wherein the elements, their technical characteristics and their relationships are at least one of interactively enterable and amendable (fig. 3, # 302; col. 4, lines 8-62; col. 5, lines 49-55).

6) The configuration tool as claimed in claim 2, wherein the elements, their technical characteristics and their relationships are at least one of interactively enterable and amendable (fig. 3, # 302; col. 4, lines 8-62; col. 5, lines 49-55).

7) The configuration tool as claimed in claim 3, wherein the elements, their

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technical characteristics and their relationships are at least one of interactively enterable and amendable (fig. 3, # 302; col. 4, lines 8-62; col. 5, lines 49-55).

8) The configuration tool as claimed in claim 5, wherein the technical characteristics for the elements are set by selecting one element from a catalog of elements with defined element-specific characteristics (col. 1, lines 24-40).

9) The configuration tool as claimed in claim 1, wherein the check for compatibility includes a check of the nature of the first and of the second element, a check of the existing relationship and a check as to whether the first element satisfies a technical condition which is dependent on at least one of the nature of the second element and of the existing relationship (col. 5, line 49 to col. 6, line 59).

10) The configuration tool as claimed in claim 9, wherein the condition can be selected from a set of conditions which are stored in at least one of a file and a file system (Fig. 3B-3D).

11) The configuration too of claim 10, wherein the file is an ASCII file (fig. 1).

12) The configuration tool as claimed in claim 2, wherein the check for compatibility includes a check of the nature of the first and of the second element, a check of the existing relationship and a check as to whether the first element satisfies a technical condition which is dependent on at least one of the nature of the second element and of the existing relationship (col. 5, line 49 to col. 6, line 59).

13) The configuration tool as claimed in claim 12, wherein the condition can be selected from a set of conditions which are stored in at least one of a file and a file system (Fig. 3B-3D).

14) The configuration tool of claim 13, wherein the file is an ASCII file (Fig. 1).

15) The configuration tool as claimed in claim 5, wherein the entered or amended elements, their technical characteristics and their relationships can be stored as at least one of a file and a file system (Fig. 1).

16) The configuration tool of claim 15, wherein the file is an ASCII file (Fig. 1).

17) The configuration tool as claimed in claim 1, wherein the elements are electrical elements, and the characteristics are at least one of electrical, electronic and electromechanical characteristics (intended use – col. 5, lines 2-44).

18) The configuration tool as claimed in claim 2, wherein the elements are electrical elements, and the characteristics are at least one of electrical, electronic and electromechanical characteristics (intended use – col. 5, lines 2-44).

19) The configuration tool as claimed in claim 17, wherein the elements are low voltage switching devices and their upstream and downstream elements (intended use – col. 5, lines 2-44).

20) The configuration tool as claimed in claim 18, wherein the elements are low voltage switching devices and their upstream and downstream elements (intended use – col. 5, lines 2-44).

21) The configuration tool of claim 1, embodied in a memory (Fig. 1).

22) The configuration tool of claim 1, embodied in a computer readable medium (Fig. 1).

23) The configuration tool of claim 2, embodied in a memory (Fig. 1).



24) The configuration tool of claim 2, embodied in a computer readable medium (Fig. 1).

25) An apparatus comprising:

a memory for storing a computer aided configuration tool including technical characteristics which can be set for each element in the configuration tool, wherein only the setting of technical characteristics for a first element is permissible, on the basis of which it remains compatible with a second element with which it is intended to be related; and input means for permitting at least one of entry and change of at least one of an element, a technical characteristic, and element relationships (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 21; col. 8, lines 1-10).

26) An apparatus comprising:

a memory for storing a computer aided configuration tool including technical characteristics which can be set for each element in the configuration tool, wherein the characteristics of a first element and of a second element and a relationship that exists between these elements, are used to check whether the first element is compatible with the second element (Fig. 2-3; col. 1, lines 54-60; col. 2, lines 1-23; col. 5, line 49 to col. 6, line 59; col. 8, lines 1-10); and

input means for permitting at least one of entry and change of at least one of an element, a technical characteristic, and element relationships (Fig. 1; fig. 3 # 302).

### **Conclusion**

**11. Any inquiry concerning this communication or earlier communications from the examiner should be:**

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directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

**or**

the examiner's supervisor, Jean Homere, telephone number (571) 272-3780.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051 (for formal communications intended for entry)

**or** (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

Dr. Hugh Jones

Primary Patent Examiner

July 23, 2005

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